

REMARKS

This submission is in response to the final Office Action mailed November 21, 2006. Claim 16 is pending. Claims 1-15 have been cancelled.

Claim 16 is amended herein to correct antecedent basis, to remove the terms “including mammals”, and to add “wherein the compound has an anti-tumor effect.” Support for the claim amendments can be found, for example, in the Examples and on page 7, lines 23-27, and on page 5, lines 3-17 of the specification. No new matter has been introduced by way of this amendment. Reconsideration is respectfully requested.

I. Rejections under 35 U.S.C. § 112, ¶ 2

Claim 16 stands rejected under 35 U.S.C. §112, ¶2. Specifically, the Examiner states that the terms “including man” are indefinite. In response, Applicants amend the claim to remove the noted terms to remove any indefiniteness. Applicants submit that the specification fully supports the interpretation of “mammals” to include animal models as well as humans. This is evidenced in the Examples and on page 7, lines 23-27, of the specification. Therefore, Applicants respectfully submit that the claim amendment overcomes the rejection. Accordingly, Applicants respectfully request that the rejection be withdrawn.

II. Rejections under 35 U.S.C. § 102(b)

Claim 16 stands rejected as anticipated under 35 U.S.C. § 102(b) over the Merck Manual. Specifically, the Examiner asserts that the Merck Manual discloses the use of THC for the treatment as an anti-emetic for cancer patients, and therefore the Merck Manual inherently teaches the treatment of the underlying glioblastoma. Applicants traverse the rejection and request reconsideration.

In order for a reference to anticipate a claim under 35 U.S.C. § 102(b), it must disclose *each and every limitation* of the claimed invention. *Dana Corp. v. Am. Axle & Mfg., Inc.*, 61 USPQ2d 1609 (Fed. Cir. 2002). To inherently anticipate, the allegedly inherent limitation must: 1) necessarily be present in the reference, as opposed to possibly present; 2) always be present;

and 3) be recognized as necessarily present by a person of ordinary skill in the art. See *Crown Operations International, Ltd. v. Solutia Inc.*, 289 F.3d 1367, 1374 (Fed. Cir. 2002). With regard to inherent anticipation, “the Examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP § 2112 (emphasis added). But “[t]he fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” MPEP § 2112.

Applicants submit that the Merck Manual discloses the use of THC for anti-emetic purposes. However, contrary to the Examiner’s assertions, Applicants submit that the Merck Manual does not specifically or inherently teach the use of THC to treat a glioblastoma. Further, in no way does the Merck Manual provide any teaching that such a method of treatment is even a possibility. Applicants submit that one skilled in the art would not use a teaching of an anti-emetic as a natural flow to a teaching of treating glioblastomas. Assuming arguendo that the Merck Manual provides a basis that the method of treatment may occur, which Applicants do not concede, the Examiner has still failed to provide sufficient basis to establish inherent anticipation of the claimed invention. Certainly, any administration of THC would not necessarily produce an anti-tumor effect in the recipient (who typically would not have a tumor).

Therefore, Applicants submit that claim 16 is not anticipated by the Merck Manual. Accordingly, Applicants request that the rejection be withdrawn.

III. Conclusion

Therefore, in view of the above amendments and remarks, it is respectfully requested that the application be reconsidered and that all pending claims be allowed and the case passed to issue. If there are any other issues remaining which the Examiner believes could be resolved through either a Supplemental Response or an Examiner's Amendment, the Examiner is respectfully requested to contact the undersigned at the telephone number indicated below.

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Respectfully submitted,

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